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NC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/984,615	12/03/97	KHANDROS	I TESSERA3.3-0

MM42/0913
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EXAMINER

CLARK, S

ART UNIT	PAPER NUMBER
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2815

13

DATE MAILED: 09/13/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/984,615

Applicant(s)
Khandros et al

Examiner
S.V.Clark

Group Art Unit
2815



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 61-76 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 61-76 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 61-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 5,679,977. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are all in "comprising" format and are therefore open to the inclusion of the elements not specifically recited (See *In re Schneller supra*). All claims contain basically four elements, the semiconductor chip having a front surface with contacts, a dielectric or compliant layer overlying the chip front surface, a plurality of terminals supported by the dielectric or compliant layer and the terminals being connected with the contacts so as to be movable with respect to the contacts. The disclosure of the application and patents with respect to Figure 4 are identical

Claims 72-73, 75, 76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,148,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the claims are all in "comprising" format and are therefore open to the inclusion of the elements not specifically recited (See In re Schneller supra). All claims contain basically four elements, the semiconductor chip having a front surface with contacts, a dielectric or compliant layer overlying the chip front surface, a plurality of terminals supported by the dielectric or compliant layer and the terminals being connected with the contacts so as to be movable with respect to the contacts. The disclosure of the application and patents with respect to Figure 4 are identical.

The disclosures of the application and US patent 5,679,977 are identical and in view of the fact that claim 18 of US Patent '977 is generic in form, it also covers the embodiment of fig. 18 to which the application claims 61-71 are directed. A similar analysis can be given between patent claim 18 and application claims 61-71..

Claims 1-76 are rejected.

Any inquiry concerning this communication should be directed to Examiner S. Clark at telephone number (703) 308-4924.

August 17, 1999


SHEILA V. CLARK
EXAMINER
GROUP 2800